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February 15, 2005

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Art Unit: 1631
Examiner: M.L. Borin
Conf. No.: 6590

Re: U.S. Patent Application Serial No. 09/960,481 filed September 24, 2001
Inventors: Joseph R. BYRUM *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Atty Dkt.: 16517.310

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Request for Suspension of Appeal; and
2. Return postcard.

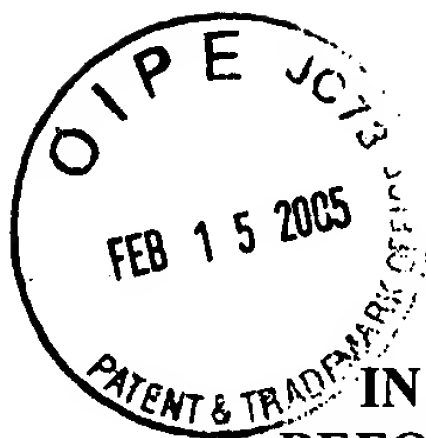
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Appellants do not believe any additional fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.310. A duplicate copy of this letter is enclosed.

Sincerely,

Thomas E. Holsten (Reg. No. 46,098)
David R. Marsh (Reg. No. 41,408)

Enclosures



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Joseph R. BYRUM *et al.*

Appln. No.: 09/960,481

Filed: September 24, 2001

For: Nucleic Acid Molecules and Other Molecules Associated with Plants

Art Unit: 1631

Examiner: Michael L. Borin

Atty. Docket: 16517.310

Confirmation No.: 6590

Request for Suspension of Appeal

Mail Stop Appeal Brief - Patents
Director of the U.S. Patent and Trademark Office
P.O. Box 1405
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal

Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.¹

On July 26, 2004 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on September 27, 2004 and an Examiner's Answer was mailed on December 15, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.²

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8th Edition, Revision No. 2, at page 1200-31.

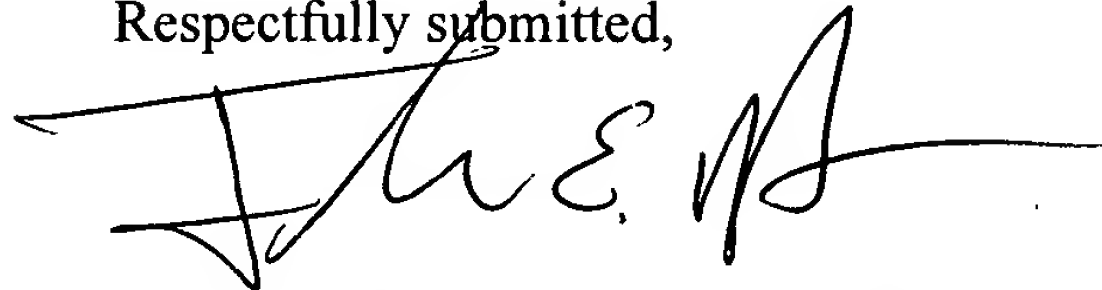
For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require

¹ Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. *See*, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

² The Board has upheld Examiners' utility rejections in similar appeals. *See, e.g.* Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. R. Marsh', with a long horizontal flourish extending to the right.

David R. Marsh (Reg. No. 41,408)
Thomas E. Holsten (Reg. No. 46,098)

Date: February 15, 2005

Of Counsel
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Thomas E. Kelley (Reg. No. 29,938)

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